

## REMARKS

### Status Summary

Claims 1-38 are pending in the present application, of which claims 1, 18, 35 and 37 are presented in independent form. No claims have been allowed and claims 1-38 stand rejected.

### Specification

The specification stands objected to as "failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(I) and MPEP § 608.01(O)." The Office states "Correction of the following is required: claims 18-34 recites the limitation 'computer readable medium'".

The Office objects to the specification as failing to provide antecedent basis for the term "computer-readable medium" used in claims 18-34. The term "computer-readable medium," however, has a well known meaning in this art. In accordance with MPEP 2111.01(II), "[t]he ordinary and customary meaning of a claim term is the meaning that a term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the application." (Citing *Philips v. AWH Corp.*, 75 USPQ 2d 1321 (Fed. Cir. 2005)). As is known in this art, a "computer-readable medium" can include one or more of any suitable media for storing the executable instructions of a computer program in one or more of an electronic, magnetic, optical, and electromagnetic form, such that the instruction execution machine, system, apparatus, or device can read (or fetch) the instructions from the computer readable medium and execute the instructions for carrying out the described methods. A non-exhaustive list of conventional exemplary computer readable medium includes: a portable computer diskette; a random access memory (RAM); a read only memory (ROM); an erasable programmable read only memory (EPROM or Flash memory); optical storage devices, including a portable compact disc (CD), a portable digital video disc (DVD), and the like.

In accordance with MPEP 608.01(o), "[i]f the examiner determines that the claims presented late in prosecution do not comply with 37 CFR 1.75(d)(1), applicant will be required to make appropriate amendment to the description to provide clear support or antecedent basis for the terms appearing in the claims provided no new matter is introduced." Here the claim terminology in question is as originally filed and was not presented late in prosecution. Accordingly, the subject matter in question was included in the application as originally filed. Nevertheless, the specification has been amended to include antecedent basis for the term computer-readable medium based on the ordinary and customary meaning known in the art, as described above. Accordingly, no new matter has been added.

#### Claim Rejection(s) - 35 U.S.C. § 102

Claims 1-38 stand rejected as being anticipated by U.S. Patent No. 6,073,142 to Geiger, et al. (hereinafter "Geiger").

To support a rejection under 35 U.S.C. § 102, each and every feature of the claimed invention must be shown in a single prior art document. In re Paulsen, 30 F.3d 1475 (Fed. Cir. 1994); In re Robertson, 169 F.3d 743 (Fed. Cir. 1999). The pending claims positively recite limitations that are not disclosed (nor suggested) in the cited document.

Specifically, claim 1 includes a recitation directed to "if the electronic message matches the criteria, displaying a graphic associated with the action when the electronic message is viewed at the client and executing the action if the graphic is selected." Geiger fails to disclose or even suggest such a recitation.

The Office cites Figure 19-20, blocks 1907,1909,1911,1913,1915 and the description found at column 23, lines 5-36 as disclosing the above referenced recitation. The cited sections of Geiger fail to disclose or suggest the above referenced recitation. The Office relies on the business rules disclosed in Geiger as anticipating the filter recitation of the instant claim. Specifically, the business

rules in Geiger are direct to gating. Geiger teaches "gating" (C7:9-13, C7:44-47) where one of the automatic actions is to send the mail for review to an administrator who is NOT the recipient.

Nevertheless, Applicant will address the above referenced recitation with regard to the administrator views. The administrator can access the "gated" mail via an administrator client illustrated in Figures 19 and 20 and described in Column 9 lines 42-43, Column 10 lines 54-55, and Column 23 lines 58-60. Figure 19 illustrates a GUI showing a message list and Figure 20 illustrates a GUI presented after selection of a message from the message list for review. The buttons illustrated in each of Figures 19 and 20 are static buttons that are presented every time the sample screen in Figures 19 and 20 are presented. There is simply no teaching or suggestion in Geiger that the display of the buttons in either Figure 19 or Figure 20 is in any way related to matching a filter. Use of the buttons is at the discretion of the reviewer/administrator, and the buttons available are always present.

The graphic buttons in Geiger are displayed independent of the business rules disclosed in Geiger. For example, button 1907 is a review button. The review button merely allows a message to be reviewed in the screen illustrated in Figure 20. The review button itself is not presented based on the electronic message meets the criteria. Rather, this button is presented each time the sample screen illustrated in Figure 19 is shown. It is clear from the cited sections that the gatekeeper screen 1901 is displayed when the gatekeeper logs on. The gatekeeper screen 1901 displayed includes the buttons discussed above. As the buttons are displayed as part of gatekeeper screen 1901 at log on, the buttons cannot said to be displayed if the electronic message matches the criteria. In response to Applicant's arguments, the Office states:

Using the same analysis, provided by applicant representative, one having ordinary skill in the art would recognize "Gatekeeper" with different gatekeeper actions and roles. Such roles or action could be a "review" or "release" as shown in action gatekeeper Graphical User Interface. For example, Figure 19 is "Gatekeeper" GUI where gatekeeper has an access to take available action for Gated

messages and therefore, all graphic or action buttons, 1907 . . . 1915, are displayed. These buttons are displayed because the electronic message follow the rule to display all graphic buttons and one having ordinary skill in the art would clearly recognize this without any brief clarification.

The Office offers no support for the conclusory statement that “these buttons are displayed because the electronic message follows the rule to display all graphic buttons.” There is simply no support for this conclusory statement in Geiger at all. The buttons shown in Figure 19 are displayed irrespective of the messages included in Figure 19. There is no teaching whatsoever of the buttons illustrated in Figure 19 being based on any rule. Further, such a conclusory statement cannot form a basis for a proper rejection under 35 U.S.C. § 102.

Further, the Office states that “one having ordinary skill in the art would clearly recognize this without any brief clarification.” The importance of a determination of the knowledge of one of ordinary skill in the art is pertinent for an obviousness rejection under 35 U.S.C. § 103. It is unclear to Applicant as to how such a determination can be used in a rejection under 35 U.S.C. § 102. As stated above, to support a rejection under 35 U.S.C. § 102, each and every feature of the claimed invention must be shown in a single prior art document. Any analysis of the knowledge of one having ordinary skill in the art has no place in a rejection under 35 U.S.C. § 102. Applicant respectfully requests the Office reconsider and withdraw the rejection made under 35 U.S.C. § 102.

The Office continues stating, “Note the ‘review’ graphic button is not displayed, it follows the rule to display other graphic buttons except ‘review’ and one having ordinary skill in the art must recognize this.” The Office again offers no support for the conclusory statement that “it follows the rule to display other graphic buttons except ‘review’.” There is simply no support for this conclusory statement in Geiger at all. Figure 19 illustrates the GUI showing a list of messages presented upon login. Figure 20 illustrates a GUI that is presented upon selection of a message for review. It logically follows that the review button would not be shown in the review GUI illustrated in Figure 20. The buttons

shown in Figure 20 are displayed irrespective of the message illustrated in Figure 20. There is no teaching whatsoever of the buttons illustrated in Figure 20 being based on any rule. Further, such a conclusory statement cannot form a basis for a proper rejection under 35 U.S.C. § 102.

Further, the Office states that "one having ordinary skill in the art must recognize this." As stated above, the importance of a determination of the knowledge of one of ordinary skill in the art is for use in an obviousness rejection under 35 U.S.C. § 103. It is unclear to Applicant as to how such a statement can be used in a rejection under 35 U.S.C. § 102. As stated above, to support a rejection under 35 U.S.C. § 102, each and every feature of the claimed invention must be shown in a single prior art document. Any analysis of the knowledge of one having ordinary skill in the art has no place in a rejection under 35 U.S.C. § 102. Applicant respectfully requests the Office reconsider and withdraw the rejection made under 35 U.S.C. § 102.

Accordingly, since Geiger fails to disclose each and every feature of the claimed invention for at least the above reasons, claim 1 is not anticipated by Geiger. Further, claims 18, 35 and 37 contain analogous recitations to those discussed above and are allowable for at least the same reasons. Furthermore, rejected claims 2-17, 19-34, 36, and 38 are novel and inventive for at least the same reasons.

Further, claim 1 includes a recitation directed to displaying the graphic "when the electronic message is viewed at the client." Another recitation in claim 1 is directed to "receiving an electronic message for a client." The client receiving the electronic message is the antecedent basis for the client discussed in the recitation above. Accordingly, the client is the receiver of the message. As such, the above recitation is directed to displaying the graphic with the receiver of the message receives the message.

In contrast, Geiger illustrates an administrator client for a gatekeeper managing the message. The gatekeeper is not the receiver of the message. As discussed above, the buttons included in the gatekeeper screen that are cited as

anticipating the above referenced recitation are displayed in response to a gatekeeper logging on. The buttons are not displayed when the electronic message is received by the client. This is clear in that the buttons in the gatekeeper screen are all for performing actions prior to the client receiving the message. That is, the buttons are associated with actions that either provide the client with the message or prevent the client from receiving the message. If the buttons discussed above all perform actions prior to the client receiving the message, the buttons cannot be displayed "when the electronic message is viewed at the client."

The Office relies on the background section stating "The e-mail client applications are end-user applications for creating, reading, and managing a user's individual e-mail account" as disclosing the above referenced recitation. Applicant does not deny that Geiger discloses email applications that allow a user to view email messages. What is not disclosed in Geiger is displaying a graphic associated with the action "when the message is viewed at the client." There is simply no disclosure of anything other than the message being displayed when the message is viewed on the client, much less displaying a graphic associated with the action. As stated above, if the buttons discussed above all perform actions prior to the client receiving the message, the buttons cannot be displayed "when the electronic message is viewed at the client." As such, Geiger cannot be said to disclose "if the electronic message matches the criteria, displaying a graphic associated with the action when the electronic message is viewed at the client and executing the action if the graphic is selected" as recited in claim 1.

Accordingly, since Geiger fails to disclose each and every feature of the claimed invention for at least these reasons as well, claim 1 is not anticipated by Geiger. Further, claims 18, 35 and 37 contain analogous recitations to those discussed above and are allowable for at least the same reasons. Furthermore, rejected claims 2-17, 19-34, 36, and 38 are novel and inventive for at least the same reasons.

As stated above, claims 3-5, 7-9, 11-12, and 14 are allowable for at least the same reasons stated above. Further, each of these claims contains additional recitations that are not disclosed or suggested by Geiger. Applicant presented arguments in the paper dated January 9, 2008 regarding the above referenced claims. The Office failed to address these arguments and simply repeats the text from the rejection made in the previous Office Action without noting Applicant's traversal of the rejection. MPEP section 707.07(f) requires the Office to answer all material traversed. Specifically, the section states, "where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." Applicant respectfully requests the Office specifically address the below presented arguments.

Specifically, claim 3 includes a recitation directed to "placing the electronic message with the action list in the recipient's inbox." The action cites Column 19, line 52 - column 21 line 24 of Geiger as anticipating this recitation. Applicant has reviewed Geiger and can find no reference in the cited section (or any other section for that matter) to "placing the electronic message with the action list in the recipient's inbox." As stated above, Geiger does not discuss a recipient inbox in any manner other than describing in the background, and e-mail client application by stating "e-mail client applications are end-user applications for creating, reading, and managing a user's individual e-mail account." This section cannot be said to anticipate "placing the electronic message with the action list in the recipient's inbox" as recited in claim 3. If the Examiner disagrees, the Examiner is requested to point out particularly where this feature is disclosed or suggested in the cited document.

Further, claims 4 and 5 include recitations directed to "inserting computer code into the electronic message if the electronic message matches the criteria" and to "inserting a graphic associated with each action in the action list into the electronic message" respectively. There is no teaching or suggestion in Geiger of inserting code or a graphic into the message or the action list. The action cites

"Figure 19-20, blocks 1907, 1909, 1911, 1913, 1915 are graphic buttons, column 23, lines 5-36" and "column 1, line 35 - column 2, line 14" of Geiger as anticipating these recitations. Applicant has reviewed Geiger and can find no reference in the cited section (or any other section for that matter) to "inserting computer code into the electronic message" or "inserting a graphic associated with each action in the action list into the electronic message." There is simply no discussion in Geiger of inserting computer code into a message or a graphic into an action list. If the Examiner disagrees, the Examiner is requested to point out particularly where this feature is disclosed or suggested in the cited document.

Claims 7-9 and 14 each include recitations directed to actions taken at the client. The Action cites column 21, line 26 - column 22 line 10 and column 23, lines 5-36 as anticipating the recitations included in claims 7-9. As discussed above, the actions taken in Geiger are all taken at the server by a gatekeeper. Applicant has reviewed Geiger and can find no reference in the cited section (or any other section for that matter) to actions taken on the client. There is no reference to actions taken at the client that receives the message. If the Examiner disagrees, the Examiner is requested to point out particularly where this feature is disclosed or suggested in the cited document.

Claims 11-12 include recitations directed to "the criteria of the filter are customizable for a recipient" and "the action is customizable for a recipient." The Action cites "Figure 4B, for automatic and manual review with Figures 6-8 that shows different options to configure filters and rules" as anticipating the recitations described above. Applicant has reviewed Geiger and can find no reference in the cited Figures (or any other Figure or section for that matter) to criteria or actions customizable for a recipient. There is no reference to any recipient based customization. Figures 4B and 6-7 all describe actions and criteria that are based on the gatekeeper role and not the recipient. Figure 8 shows a GUI for creating rules based on message properties such as size and attachment size. There is simply no disclosure or suggestion of recipient based



customization of criteria of the filter or of an action in Geiger. If the Examiner disagrees, the Examiner is requested to point out particularly where this feature is disclosed or suggested in the cited document.

Accordingly, as Geiger fails to disclose each and every feature of the claims for at least the above reasons as well, claims 3-5, 7-9, and 11-12 are not anticipated by Geiger.

#### CONCLUSION

In view of the above, it is respectfully submitted that the present application is now in proper condition for allowance, and an early notice to such effect is earnestly solicited. Entry and favorable consideration of the above remarks is respectfully requested. The Examiner is respectfully requested to telephone the undersigned patent attorney at the below-listed number if, after reviewing the above Remarks, the Examiner believes outstanding matters remain that may be resolved without the issuance of a subsequent Official Action.

#### DEPOSIT ACCOUNT

The Commissioner is hereby authorized to charge any additional fees, or credit any overpayment, associated with the filing of this paper to Deposit Account No. **50-3512**.

Respectfully submitted,

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